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RJH

Paper No. 20

AUG 23 2001

In re Application of:
BOEHRINGER ET AL.
Serial No.: 08/812,616
Filed: March 06, 1997
For: Quantitative Lateral Flow Assays and Devices

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed June 28, 2001, to withdraw the holding of abandonment.

This application was filed as a continued prosecution application on January 21, 1999. On February 23, 2000, a final Office action was mailed to applicants. On September 1, 2000, a non-final Office action was mailed to applicants which vacated the February 23, 2000 Office action. The February 23, 2000 Office action was presumably vacated because it did not take into consideration a preliminary amendment filed on January 6, 2000 (certificate of mailing dated January 3, 2000). The original amendment filed January 6, 2000 is present in the file as are several copies that were faxed to the Office. On May 8, 2001, a notice of abandonment was mailed to applicants which indicated that the application was abandoned for failure to timely file a proper response to the September 1, 2000 Office action. On June 28, 2001, the present petition was filed.

Petitioner asserted that the abandonment should be withdrawn since a response was timely filed with a three month extension of time on March 5, 2001 (certificate of mailing dated March 1, 2001). Along with the petition, petitioner filed a copy of the response and the three month extension of time.

A review of the file revealed that the response and three month extension of time filed on March 5, 2001 were present in the application. It appears that the problem arose because the examiner thought that the March 5, 2001 response was merely a copy of the January 6, 2000 amendment and not a response to the September 1, 2000 Office action. In fact, the word "Duplicate" was written by someone on the top of the paper. Hence, the examiner abandoned the application for failure to respond to the September 2, 2000 Office action. However, the timely filing of the March 5, 2001 paper and extension of time and their presence in the application does not dispose of the issue of abandonment. For abandonment to be withdrawn, the March 5, 2001 paper must

Art Unit: 1600

be either fully responsive to the September 1, 2000 Office action or at least a *bona fide* attempt to advance the application to a final action. See 37 CFR 1.111, 37 CFR 1.135(c), and MPEP 714.12-714.03.

To determine whether the March 5, 2001 paper constitutes a proper response or a *bona fide* attempt to respond to the September 1, 2000 Office action a comparison of the paper with the January 6, 2000 amendment was done. This comparison revealed the following:

--The March 5, 2001 paper does indicate on page 1 that it is in response to the September 1, 2000 Office action whereas the January 6, 2000 paper indicates that it is a preliminary amendment.

--The amendments on page 1 through page 6, line 9, of the March 5, 2001 paper are identical to the amendments in the same place of the January 6, 2000 paper. Thus, it is not seen why such amendments were necessary to present in the March 5, 2001 paper.

--The March 5, 2001 paper attempted to add claims 121-143 whereas the January 6, 2000 paper added claims 121-125. Thus, the attempt to add claims 121-143 was confusing especially since claims 121-123 and 131 were identical to claims 122-125 as added by the January 6, 2000 paper.

--The "REMARKS" section of the March 5, 2001 paper only differed from the "REMARKS" section of the January 6, 2000 paper to a very minor degree. Two examples are: the claim numbers that should be pending listed in the second paragraph of the "REMARKS" section in both papers; and, the explanation as to what the Lou reference teaches (the explanation appears under section II in both papers). There is no real difference in the substance of the remarks of the two papers.

In addition, a comparison was done of the March 5, 2001 paper with the September 1, 2000 Office action. This comparison revealed the following:

--The paper argued a rejection under 35 U.S.C. 112, second paragraph, that was never made in the Office action.

--The paper argued a rejection of claims 1, 2, 5, 6, 13, 14, 53, 54, and 58 under 35 U.S.C. 102 over Lou et al whereas the rejection made in the Office action was only of claims 124 and 125.

--The claims listed in arguing many of the other rejections do not correspond with the claims rejected by the examiner in the Office action.

--There are art rejections argued in the paper that do not appear in the Office action, e.g., Lou in view of Weng, Lou in view of Katz, and Lou in view of Bunting.

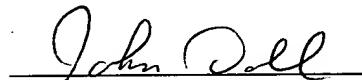
--The paper fails to address the rejection of claims over Lou et al in view of Maggio et al and further in view of Eisinger et al as set forth in the September 1, 2000 Office action.

Art Unit: 1600

--Page 17 of the paper indicated that applicants consider claims 10 and 62 as being allowed. However, the Office action rejected those claims as being unpatentable over Lou et al in view of Maggio et al and further in view of Eisinger et al.

In view of the above noted comparisons, it has reasonably been concluded here that the March 5, 2001 paper is not fully responsive to the September 1, 2000 Office action and that the March 5, 2001 paper does not even constitute a *bona fide* attempt to advance the application to a final action. See 37 CFR 1.111, 37 CFR 1.135(c), and MPEP 714.12-714.03. With no proper and timely response to the September 1, 2000 Office action, there is no proper reason to withdraw the holding of abandonment.

PETITION DENIED.


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